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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,336	10/30/2001	Bernhard Lettmann	IN-5530	2515
26/922 7590 04/02/2008 BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192				
EXAMINER ASINOVSKY, OLGA				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 04/02/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/018,336

Applicant(s)

LETTMANN, BERNHARD

Examiner

OLGA ASINOVSKY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 12, 13, 18, 19, 21, 22, 25, 26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 18, 19, 21, 22, 25, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/24/2008 has been entered.

There is no amendment after final rejection.

The restriction was made on 11/05/2003. Claims 12-13 and 29-32 are withdrawn with traverse of January 15, 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701.

Claim 3 is independent claim. Claimed invention is a process for preparing an aqueous coating material having desirable shade and optical effect, wherein said process comprising mixing of at least three components called modules specified in the present claim 3 comprising: module (I) containing less than 5% by weight water, at least one binder, at least one pigment, and at least one organic solvent to form a base color (A1);

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module (II) comprising at least one aqueous color module comprising at least one water-soluble or –dispersible binder, at least one color pigment and water to form at least one aqueous color-imparting base color (A2); and module (III) comprising at least one pigment-free mixing varnish module comprising (B) at least one aqueous, pigment-free varnish comprising water-soluble or –dispersible binder and water; and optionally at least one rheology control additive (C). Modules (I), (II), and (III) are stored separately and mixing before using. The nature of binder(s) is not critical.

The rejection is set in the previous office action mailed on 09/24/2007 and it is incorporated here by references.

Reusmann discloses a water-dilutable coating composition and a process for preparing water-dilutable coating compositions with precisely defined tinting, comprising the steps of: preparing a plurality of base colors; separately storing each of said base colors, and mixing, shortly before application of the coating composition, columns 17-18, claim 12, for the present claimed process in claim 3. The water-dilutable coating compositions comprises a plurality of base colors (A) and at least one pigment-free component (B), and at least one rheology-controlling additive, column 17, lines 1-6, 29-30 and 31-32. The base colors (A) comprise less than 5% by weight of water, at least one pigment, an organic solvent, and at least one water-dilutable first binder. The component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin=second binder, column 3, lines 1-3 and claim 1 at column 17, lines 5-17. The component (A) is readable for being claimed (A-1) base color in the claimed module (I), in the present claim 3. The component (B) is readable for being claimed aqueous, pigment-free varnish module

(III), in the present claim 3. The first binder (A) and the second binder in the component (B) can be the same binder, column 13, lines 25-26; column 4, lines 52-55 and column 9, lines 7-12. The polyurethane resins as binders are readable in the present claims 25-26. Water-dispersible polyurethane may contain polyacrylate, polyester and amino resins, column 11, lines 18-20. A rheology additive is readable for being the optionally claimed component (C) in the present claim 3 and 21-22. The polyurethane resins can be prepared from an isocyanate-functional prepolymer wherein said functional group is capable of forming anions, column 6, lines 10-14 and 37-41; column 7, lines 14-20 and column 11, lines 18-33, for the present claim 28. Suitable groups capable of forming anions are carboxyl groups, column 7, lines 57-58, for the present claim 28. The coating composition comprises a plurality of base colors (A). The base colors (A) comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment, column 12, lines 56-59 and column 3, lines 7-35, for the present claim 18. Suitable special-effect pigments at column 3, lines 18-28 is also can be present, for the present claim 19. The coloring pigments and special-effect pigments are readable in claimed (A1) to form module (I) in the present claim 3. The solvents are water-soluble or water-thinnable solvents such as alcohols, column 4, lines 61-62, for the present claim 3. Reference discloses a process for preparing components (A) and (B), and directly after their preparation by mixing the component (A) and (B), the coating compositions are applied to the substrate, column 13, lines 43-55. The coating compositions can be applied by spraying on various substrates, column 13, line 43 through column 14, line 17. The base colors compositions (A) can be mixed with a suitable amount of the

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aqueous component (B). Reusmann discloses a formulation of a water-dilutable coating composition, which can be diluted with water, with or without prior partial removal of the organic solvent employed in the preparing resin, column 11, lines 30-32; column 12, lines 1-7 and column 13, lines 7-17. Binders include polyurethane resins and amino resins, column 4, lines 52-55. Also, binders include polyacrylic resins such as water-thinnable or water-dispersible polyester resins, column 4, lines 26-55. The coating composition in Reusmann invention can include a plurality=various of base colors (A), wherein "coloring pigments usually takes place by dispersing the respective pigments with one or more of the above-described binders," column 5, lines 28-32.

Reusmann does not show claimed part (A2) as a separate component=module of an aqueous color module comprising pigment, binder and water. In other words, reference does not show three modules=parts of a coating composition. The claimed component (A2) is expected in Reusmann invention. Because, Reusmann discloses that a coating composition can be based on a plurality=various of base colors (A) separately storing each of said base colors, column 15, lines 48-67; column 16, lines 1-10, 65-67 and column 17, line 1. Also, a component (A) may contain from 20 to 80% by weight of at least one water-thinnable or water-dispersible binder, column 12, lines 32-33. A polyacrylate thickener in water is disclosed in Reusmann invention at column 16, lines 9-10. A worker in the art would add water-thinnable or water-dispersible binder with a desirable pigment to control=improve coatability property and control/correct color effect for an aqueous coating material.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the aqueous coating composition in Reusmann invention with additional water-thinnable or water-dispersible binder with a pigment that is considered as claimed (A2) component for the purposes to control the viscosity and coating property of the resulting coating composition and wherein an additional pigment would be expected to control the desired color effect. For this reason the coating composition in Reusmann will have the same resulting expectation as the aqueous coating composition in the present claims.

4. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701 in view of Schwarte et al U.S. Patent 6,001,915.

Reusmann has been considered in the paragraph 3 above. Reusmann does not show coating composition comprising three modules=components as claimed part (A2) of an aqueous color module comprising pigment, binder and water in the present claim 3. However, any additional compound as a tinting base color comprising water-dilutable binder is expected in Reusmann invention.

Schwarte discloses polyurethane-modified polyacrylate which is suitable for producing aqueous pigmented coating material. The water-thinnable resins which serve for dispersing the pigments are readable in Schwarte invention at column 8, lines 15-35.

Both references disclose relevant teachings of aqueous coating compositions. The base binder is the same in both reference inventions. The additional water-dilutable/water-thinnable binder is disclosed in Schwarte invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify water-dilutable coating composition in Reusmann invention by employing water-thinnable resin by teaching in Schwarte invention for the purposes to control the viscosity and coating property of the resulting coating composition in Reusmann invention and to control the color effect since water-thinnable binder serves for dispersing the pigment for a coating composition in Schwarte invention.

5. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701 in view of Kawakami et al EP 0 081 994.

6. Both references have been considered in the prior office action mailed on 09/24/2007.

7. In addition, Reusmann is considered in the paragraph 3 above.

8. Kawakami discloses compositions for an aqueous coating a paper. A composition includes a conventional pigment, binder and water, abstract and page 1, line 1; page 2, lines 30-32; page 3, lines 1-8; page 8, lines 13, 23-24 and 29-32.

Kawakami disclose a water-soluble polyamidopolyurea binder.

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9. Both references disclose an aqueous coating composition comprising a colorant, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate.

It would have been obvious to one of ordinary skill in the art to modify the aqueous coating composition in Reusmann invention by incorporating the composition in Kawakami in order to impart enhanced water resistance and desired solids content and physical properties of coating composition, because the addition composition based on binder, conventional pigment and water is expected in Reusmann invention for obtaining the desired coating color and the desired solid content with the intended use of the aqueous coating composition in Reusmann at column 13, lines 11-17.

There is no specified viscosity of an aqueous coating composition. Any amount of ingredients is expected for making a coating material.

Response to Arguments

10. Applicant's arguments filed 01/24/2008 have been fully considered but they are not persuasive. The main argument is that the combination of teachings Kawakami with Reusmann is inappropriate because using Kawakami's binder would destroy the intended use of Reusmann. The Remarks, pages 7/15 to 15-15 have been considered.

11. In response to applicant's argument that Katakami is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed

invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a binder in the present claim 3 is not critical. There is no physical/chemical property for an aqueous coating composition. Any amount of ingredients is expected in claimed coating composition. There is no "condensation resistance" property of the resulting coating composition in the present claims. There is no argument that a plurality of base colors (A) and a pigment-free binder (B) in Reusmann invention are different from the present claims. Any additional water-soluble or water-dispersible binder with pigment in water medium is expected in the primary reference. For this reason, it would be obvious to combine the teachings of these two references for modifying an aqueous coating composition in Reusmann by employing a composition of Kawakami as an addition binder, conventional pigment and water.

The burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205, USPQ 594 (CCPA 1980).

12. References cited with applicant Form 1449 have been considered. The closest reference is EP 0 471 972 cited under X category in the international search report. Reference discloses an aluminum base (aluminum pasta) component A comprising solvent, a solids=pigment and binder; pigmented base component B comprising other pigment, wax dispersion, a volatile organic solvent, binder such as acrylic latex resin and water; and component C comprising water dispersible polyurethane, a volatile organic level. Reference discloses reactive acrylic resin with an isocyanate adduct having urethane and nonionic functionality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLGA ASINOVSKY whose telephone number is (571)272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.A.
March 28, 2008

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796

